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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Kenneth W. Nimmons

Appln. No.: 09/820,091

Filed: March 28, 2001

For: BASEBALL BASE WITH IDENTIFICATION

Attorney Docket No: 2817/228

Examiner: Aryanpour, Mitra

Art Unit: 3711

REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is in response to the Examiner's Answer mailed September 23, 2004.

I. Status of Claims

The Status of Claims section of the Examiner's Answer asserted that Appellant's statement in his Appeal Brief filed on June 25, 2004 regarding the status of the claims was incorrect. In particular, the Status of Claims section asserted that claim 14 is rejected under 35 U.S.C. § 103(a). This is incorrect. Claim 14 was canceled in Appellant's Amendment filed on September 10, 2003. It is noted that the Status of Claims section also indicates that claim 14 is canceled. Accordingly, claim 14 has been shown to be canceled.

The Status of Claims section also indicated that claim 6 is rejected under 35 U.S.C. § 103(a). This is incorrect. As pointed out in footnote 2 of Appellant's Appeal Brief, Appellant incorrectly asserted in his Response to Restriction Requirement that claim 6 was a member of the elected species. Page one of the Office Action mailed on September 12, 2002 corrected this error by indicating that claim 6 was withdrawn as directed to a non-elected species. However, the Final Office Action, mailed November 24, 2003, incorrectly listed claim 6 as being rejected. Appellant believes that the record shows that claim 6 has been withdrawn from consideration.

II. Grouping of Claims

The Grouping of Claims section of the Examiner's Answer asserted that Appellant's grouping of claims in his Appeal Brief filed was not proper since it did not take into account claim 6. As pointed out above in Section I, Appellant has shown that claim 6 has been withdrawn from consideration and so Appellant's grouping of claims is proper.

Should the Board determine that claim 6 is not withdrawn from consideration and

that the rejection under 35 U.S.C. § 103(a) for being obvious in view of Bartoli, the SPORTS book, Motooka et al. and Kennedy, III et al. is applicable to claim 6, then Appellant considers the patentability of claim 6 to stand or fall together with the patentability of claims 5, 12, 41, 44 and 56.¹ Note that Appellant is filing a substitute Appendix, in triplicate, to replace the Appendix of Appellant's Brief so as to include claim 6 should it be determined that claim 6 is not withdrawn from consideration.

III. Grounds of Rejection

A. Arguments Regarding Claims 2-5, 9-18, 41 and 44-56

The Grounds of Rejection section of the Examiner's Answer provided grounds for supporting the rejections of dependent claims 2-5, 9-18, 41 and 44-56. Appellant believes that such grounds are not relevant in view of the grouping of the claims provided in Appellant's Appeal Brief. Since the patentability of the claims has been deemed for the purpose of this Appeal to depend on the patentability of independent claims 7, 8, 42 and 43, the grounds for rejecting dependent claims 2-5, 9-18, 41 and 44-56 are not relevant for the present Appeal. Accordingly, Appellant does not see the need to comment on the grounds for rejecting dependent claims 2-5, 9-18, 41 and 44-56.

¹ Should the Board deem claim 6 not withdrawn from consideration, then Sections VI-VIII should be read to include mention of claim 6 per the comments given above in Section II of the present Reply Brief.

B. Response to Appellant's Arguments

1. Claims 13 and 32

The Examiner's Answer notes that claims 13 and 32 were objected to in the Final Office Action mailed on November 24, 2003. This is not correct. Claims 13 and 32 were objected to in the non-Final Office Action mailed on April 10, 2003. Appellant's Amendment of September 10, 2003 addressed this issue by requesting that the previous reference to the cancellation of claim 13 be ignored. It is noted that the Final Office Action did ignore the previous reference to the cancellation of claim 13 and examined the claim. Accordingly, the reference to the objection made in the April 10th non-Final Office Action has no merit to the issues at hand.

2. Bartoli and SPORTS Book References

It is noted that at page 9, lines 15-18 of the Examiner's Answer it is stated that Bartoli and the SPORTS book each disclose the base structure of claims 7 and 8. This is not true. As stated on page 9 of Appellant's Appeal Brief, "the base shown in the SPORTS book does not disclose nor suggest forming a cutout in either a top face of a side wall of Bartoli's base and inserting an identification label therein." In other words, Bartoli does not have a cutout and the SPORTS book does not suggest forming a cutout in Bartoli that contains a identification label therein either. This is further evidenced by the fact that the Examiner's Answer has not identified what items of Bartoli correspond to a cutout or insert and what items in the SPORTS book correspond to an insert. Further evidence of the improperness of the statement is that claims 7 and 8 have not been rejected as being anticipated under 35 U.S.C. § 102 by Bartoli or the SPORTS book. If Bartoli and the SPORTS book did contain all of the elements of

claims 7 and 8, then a rejection under Section 102 should have been rendered. It is noted that the last line of page 9 of the Examiner's Answer suggests that Motooka et al. and Kennedy, III et al. are being relied on for suggesting forming a cutout in Bartoli. This was Appellant's understanding of the basis for the rejection as evidenced by his arguments presented in his Appeal Brief.

3. Disclosure of Cutout

It is noted that at page 10 of the Examiner's Answer there is made an assertion that Appellant's specification fails to provide a specific explanation as to how the cutout 80 is produced. This assertion is irrelevant regarding the question of whether the claims are patentable over the references relied on to reject the claims.

Page 10, lines 2-4 of the Examiner's Answer contains another irrelevant assertion that the drawings do not show a cutout. Again, this assertion is irrelevant to the issue whether the claims are patentable over the references relied on to reject the claims.

Despite the irrelevance of the above-mentioned assertions, one of ordinary skill would understand the structure of and how to make the cutout 80 in view of the disclosed dimensions of the cutout given at page 4, lines 10-12 of Appellant's Specification.

Page 10, lines 4-5 of the Examiner's Answer appears to be using the above-mentioned assertions for the proposition that they allow the claimed cutout to encompass the "recessed area surrounding the indicia of the base of the SPORTS book." Appellant objects to this proposition on two fronts. First, page 9, line 15 of the Examiner's Answer asserts that the SPORTS book is not being used to show a cutout.

The passage at page 10, lines 4-5 of the Examiner's Answer appears to assert the opposite. This is confusing to say the least and is unfair to the Appellant to guess which interpretation is being relied on.

The proposition is objected to for the additional reason that it asserts that the SPORTS book actually shows a recessed area surrounding the indicia of the base. Based on the copy of the SPORTS book sent to the Appellant by the Examiner via facsimile, it is debatable whether there are any so-called recessed areas.² At most, there appear to be a plurality of intersecting lines on the base. Assuming for arguments sake that the intersecting lines define a recessed area, there is still no motivation in the art of record to insert an identification label within such a recessed area.

4. Non-analogous Art

Page 10, lines 17-19 of the Examiner's Answer makes several comments about the novelty and unobviousness of personalizing sports paraphernalia. These comments have no bearing on whether or not Motooka et al. and Kennedy, III et al. are directed to analogous art. See, *State Contracting & Engineering Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1489 (Fed. Cir. 2003); *In re Clay*, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

² The Examiner's facsimile transmittal sheet dated July 8, 2003 indicated that the attached copy of the SPORTS book reference may not come out very clearly when faxed. That may have occurred in this case.

Page 11, lines 4-8 of the Examiner's Answer make mention of Appellant's remarks on "improving bases" and how it is unclear "how the structure of the base has been improved" (emphasis added). The confusion does not reside in Appellant's remarks. The confusion resides in the Examiner's interpretation of the remarks. In particular, Appellant's remarks do not mention that the structure of the base is improved. Appellant merely mentioned at page 10 of his Appeal Brief that one problem attempted to be solved by his base was that prior "bases do not have the ability to be identified as a game or event specific item that would make it a collectable item." Accordingly, the Examiner's confusion is not the fault of Appellant. It should also be pointed out that Appellant's invention would be considered an improvement by collectors. In addition, even if Appellant's invention provided no improvement or even a disadvantage, that would be irrelevant to the inquiry as to whether the claims were patentable. *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 960 n.12, 1 USPQ2d 1196, 1199 n.12 (Fed. Cir. 1986).

5. Printed Matter

At the paragraph beginning at page 11, line 16 of the Examiner's Answer, it is asserted that the only difference between the cited art and the claims is meaning and information conveyed by printed matter. This assertion has no merit. In particular, the first sentence of the above-mentioned paragraph asserts that Bartoli shows all of the structure of the base. As pointed out previously in Section III.B.2, this is incorrect. Bartoli fails to disclose the recited cutout and identification label inserted therein. As pointed out in Appellant's Appeal Brief at pages 11 and 12, the cited art fails to suggest forming a cutout in Bartoli's base and to have an identification label inserted therein.

Since the above identified differences between the cited art and the claims are not based on printed matter, the assertion in the paragraph has no merit.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. C. Freeman", is written over a horizontal line.

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IX. APPENDIX

2. The base of claim 7, wherein said identification label comprises indicia.
3. The base of claim 2, wherein said indicia comprises a team logo.
4. The base of claim 2, wherein said indicia comprises a league logo.
5. The base of claim 2, wherein said identification label comprises: a photopolymer coating applied over a printed image of indicia.
6. The base of claim 2, wherein said identification label comprises a release paper with a screen print imaging of said indicia that is heat transferred to either said top face or said side wall.
7. A base for use during the play of baseball or softball, comprising:
 - a bottom;
 - a top face;
 - a side wall attached to said bottom and said top face,
 - an identification label attached to said top face; and
 - wherein said top face comprises a cutout into which said identification label is inserted.
8. A base for use during the play of baseball or softball, comprising:
 - a bottom;
 - a top face;
 - a side wall attached to said bottom and said top face,
 - an identification label attached to said side wall; and
 - wherein said sidewall comprises a cutout into which said identification label is inserted.
9. The base of claim 8, wherein said identification label comprises indicia.

10. The base of claim 9, wherein said indicia comprises a team logo.
11. The base of claim 9, wherein said indicia comprises a league logo.
12. The base of claim 9, wherein said identification label comprises:
a photopolymer coating applied over a printed image of indicia.
13. The base of claim 7, further comprising:
a second sidewall attached to said sidewall, said bottom and said top face;
a third side wall attached to said second side wall, said bottom and said top face; and
a fourth sidewall attached to said sidewall, said third sidewall, said bottom and said top face.
15. The base of claim 7, further comprising a post attached to said bottom.
16. The base of claim 15, further comprising a plate attached to said post;
and
wherein said bottom comprises a lip that defines an opening into which a portion of said plate is inserted.
17. The base of claim 7, wherein said base is made of a resiliently deformable material.
18. The base of claim 17, wherein said resiliently deformable material is rubber.
32. The base of claim 13, wherein said side wall, said second side wall, said third side wall and said fourth side wall define a square-like shape.
33. The base of claim 8, further comprising:
a second sidewall attached to said sidewall, said bottom and said top face;

a third side wall attached to said second side wall, said bottom and said top face; and

a fourth sidewall attached to said sidewall, said third sidewall, said bottom and said top face.

34. The base of claim 33, wherein said side wall, said second side wall, said third side wall and said fourth side wall define a square-like shape.

35. The base of claim 8, further comprising a plate attached to said post; and wherein said bottom comprises a lip that defines an opening into which a portion of said plate is inserted.

36. The base of claim 8, wherein said base is made of a resiliently deformable material.

37. The base of claim 36, wherein said resiliently deformable material is rubber.

38. The base of claim 43, wherein said identification label comprises indicia.

39. The base of claim 38, wherein said indicia comprises a team logo.

40. The base of claim 38, wherein said indicia comprises a league logo.

41. The base of claim 38, wherein said identification label comprises:
a photopolymer coating applied over a printed image of indicia.

42. A base for use during the play of baseball or softball, comprising:
a bottom;
a top face;
a first side wall attached to said bottom and said top face,
a second sidewall attached to said first sidewall, said bottom and said top face;

a third side wall attached to said second side wall, said bottom and said top face;

a fourth sidewall attached to said first sidewall, said third sidewalk, said bottom and said top face;

an identification label attached to either said top face or said first sidewalk; and

wherein said first side wall, said second side wall, said third side wall and said fourth side wall define a square-like shape and, wherein said top face comprises a cutout into which said identification label is inserted.

43. A base for use during the play of baseball or softball comprising:

a bottom;

a top face;

a first side wall attached to said bottom and said top face,

a second sidewall attached to said first sidewall, said bottom and said top face;

a third side wall attached to said second side wall, said bottom and said top face;

a fourth sidewall attached to said first sidewall, said third sidewall, said bottom and said top face;

an identification label attached to either said top face or said first sidewall; and

wherein said first side wall, said second side wall, said third side wall and said fourth side wall define a square-like shape and, wherein said sidewall comprises a cutout into which said identification label is inserted.

44. The base of claim 43, wherein said identification label comprises:
a photopolymer coating applied over a printed image of indicia.

45. The base of claim 43, further comprising a post attached to said bottom.

46. The base of claim 45, further comprising a plate attached to said post;
and

wherein said bottom comprises a lip that defines an opening into which a portion of said plate is inserted.

47. The base of claim 43, wherein said base is made of a resiliently deformable material.

48. The base of claim 47, wherein said resiliently deformable material is rubber.

49. The base of claim 42, further comprising a post attached to said bottom.

50. The base of claim 49, further comprising a plate attached to said post;
and
wherein said bottom comprises a lip that defines an opening into which a portion of said plate is inserted.

51. The base of claim 42, wherein said base is made of a resiliently deformable material.

52. The base of claim 51, wherein said resiliently deformable material is rubber.

53. The base of claim 42, wherein said identification label comprises indicia.

54. The base of claim 53, wherein said indicia comprises a team logo.

55. The base of claim 53, wherein said indicia comprises a league logo.

56. The base of claim 53, wherein said identification label comprises:
a photopolymer coating applied over a printed image of indicia.